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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/808,226  | 03/23/2004  | Henry Welling Lane   | DIOP-07900          | 4994             |
| 34209   | 7590        | 10/12/2006           | EXAMINER            |                  |
| WESTBERG LAW OFFICES<br>2 NORTH SECOND STREET, SUITE 1390<br>SAN JOSE, CA 95113 |             |                      |                     | MAI, HUY KIM     |
|   |             | ART UNIT             |                     | PAPER NUMBER     |
|   |             | 2873                 |                     |                  |

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/808,226             | LANE ET AL.         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Huy K. Mai             | 2873                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 July 2006.

2a) This action is **FINAL**.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-39, 41-44, 46-50 and 54-59 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 57 and 58 is/are allowed.

6) Claim(s) 1-4, 13-20, 35-39, 41-44, 46-50 and 54-56 is/are rejected.

7) Claim(s) 5-12, 21-34 and 59 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

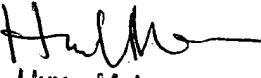
#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
 Huy Mai  
 Primary Examiner

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/06</u> .  | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) filed Jul. 21, 2006 is acknowledged.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 13-16, 35-37 and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin (2004/057008).

The limitations in claims 1, 13-16, 35-37 and 54 are shown in Lin's Figs. 1-7, page 1, column 2 to page 2, column 1. Lin discloses an eyeglass assembly comprising an eyeglass frame 20 having lens receptacles; and a rib 30 coupled to the eyeglass frame and including a brow portion, the brow portion having side portions extending above the lens receptacles and the rib having extensions coupled to the brow portion and extending downwardly along both sides of a wearer's nose, each side portion and each extension 22 terminating at an endpoint, and the rib having a pliable coating on at least some of its surface.

Regarding claim 54, Lin discloses an eyeglass assembly comprising an eyeglass frame 20 having lens receptacles; and a rib 30 including a brow portion and extensions 22, the brow portion having side portions extending above the lens receptacles, the extensions 22 extending

downwardly along both sides of a wearer's nose, each of the side portions and each of the extensions terminating at an endpoint, the rib having a pliable coating on at least some of its surface, the rib having a plurality of tabs 24 affixing the rib to the eyeglass frame, the plurality of tabs 24 including at least one tab 26 positioned near each of left and right ends of the brow portion of the rib, and the plurality of tabs including at least one tab 23 positioned near each of the ends of the extensions.

4. Claims 1, 13-16 and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Canavan (6,196,681).

The limitations in claims 1, 13-16 and 35-37 are shown in Canavan's Figs. 1-4, column 2. Canavan discloses an eyeglass assembly comprising an eyeglass frame 12A having lens receptacles; and a rib 12B coupled to the eyeglass frame and including a brow portion, the brow portion having side portions extending above the lens receptacles and the rib having extensions coupled to the brow portion and extending downwardly along both sides of a wearer's nose, each side portion and each extension 12D terminating at an endpoint, and the rib having a pliable coating on at least some of its surface.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 2-4, 17-19, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin.

Lin discloses an eyeglass assembly comprising an eyeglass frame 20 having lens receptacles; and a rib 30 coupled to the eyeglass frame and including a brow portion, the brow portion having side portions extending above the lens receptacles and the rib having extensions coupled to the brow portion and extending downwardly along both sides of a wearer's nose, each side portion and each extension 22 terminating at an endpoint, and the rib having a pliable coating on at least some of its surface wherein the rib is affixed to the eyeglass frame by at least one fastener 26, 23 and at least one attachment means 24 being integral to the rib and the eyeglass frame, wherein the fastener (or the post) 23 protrudes from the eyeglass frame and passing the hole 33 in the extension 22 to secure to another one of the rib and the eyeglass frame. However Lin does not discuss whether the fastener (or the post) 23 is separate from the eyeglass frame and passing through an aperture of the eyeglass frame, as claimed. It is commonly known in the art that a post or a screw a first element passes an aperture in a first element and passes a hole in a second element for securing the first element to a second element. Therefore it would have been obvious at the time the invention was made to those having skill in the art to modify the post 23 in the Lin's eyeglass assembly by forming an aperture in the eyeglasses and using a separate post or screw passing the aperture in the eyeglass frame and the hole in the rib, as common knowledge in the art, for the same purpose of securing another one of the rib and the eyeglass frame.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin.

Lin discloses the claimed invention as discussed above, except for the tabs 24 extending from the rib instead of the tabs extending from the eyeglass frame and a corresponding tab receptacle as claimed. It appears that the connection between the tab (male) and the corresponding tab receptacle (female) is a connection between male and female for securing the rib and the eyeglass frame together. It is commonly known in the art that a connection between two elements wherein a male formed in one of the two elements and a female formed in the other of the two elements. It would have been obvious at the time the invention was made to those having skill in the art to modify the coupling means in the Lin reference by forming the tabs extending from the eyeglass frame and a corresponding tab receptacle in the rib, as a common knowledge in the art, for the same purpose of securing the rib and the eyeglass frame together.

8. Claims 38, 39, 41-43,46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin.

It should be noted that although claims 38, 39, 41-43,46-50 "method claims", the method steps consist of the broad steps of "forming", "molding" and "affixing" etc and therefore these steps would be inherently satisfied by the apparatus of the Lin reference as modified.

Regarding claim 43, the limitations in claims 43 are substantially the same to that in claim 20. The rejection applied to claim 20 would apply to claim 43.

*Allowable Subject Matter*

9. Claims 57 and 58 are allowed.

10. Claims 5, 8, 21, 23, 30 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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11. Claims 6, 7, 9-12, 22, 24-29, 31-34 and 59 are objected to as being dependent upon the above objected claims.

*Response to Arguments*

12. Applicant's arguments with respect to claims 1-39, 41-44, 46-50, 54-59 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai  
Primary Examiner  
Art Unit 2873

HKM/  
October 2, 2006